

REMARKS

In the Office Action mailed June 16, 2004, the Examiner rejected claims 1, 3-18, 20 and 21. By way of the foregoing amendments and the markings to show changes, Applicants have amended claims 1, 9 and 11. The foregoing amendments are taken in the interest of expediting prosecution and there is no intention of surrendering any range of equivalents to which Applicant would otherwise be entitled in view of the prior art.

I. Claim Rejections under 35 USC 103

The Office Action rejected claims 1, 3-18, 20 and 21 as being unpatentable over Hill et al. (US patent 6,493,920) in view of various combinations of Miyazaki et al. (US patent 4,883,310), Hsieh (US patent 5,115,086), Bhat et al. (US patent 6,133,398), Wandiez (US Patent 6,409,947), Johnston (US Patent 4,712,287), Meritor Automotive (February 2000), Allen et al. (US Patent 6,423,755), Bergholz et al. (US Patent 6,151,539) and Lumpe et al. (US Patent 6,592,176). Applicants traverse these rejections. Applicants have amended claims 1, 9 and 11 to expedite prosecution and believe that claims 1, 9, 11 and their dependents are in condition for allowance. Applicants specifically traverse the rejection of claims 6, 14, 17, 18 and 21.

Claims 6 and 14

Applicants assert that the Office Action has failed to establish a prima facie case of obviousness against claims 6 and 14. In particular, the motivation for combining the Johnston reference with the Hill et al. and Miyazaki is unclear and therefore does not establish prima facie obviousness.

In rejecting claim 6, the Office Action, at page 4-5, reads, "it is known to provide a seal against the intrusion of between the windshield and the frame of the vehicle... Therefore it would have been obvious to...have included an encapsulation covering with the windshield of Hill et al./Miyazaki, in light of the teaching of Johnston, in order to provided a seal against the intrusion of between the windshield and the frame of the vehicle..." This statement is then reiterated at page 10 of the Office Action in rejecting claim 14.

The above statement is confusing and does not provide a proper motivation for at least two reasons. First, the statement does not suggest what “intrusion” that the skilled artisan would have found it obvious to “seal against”. Moreover, the motivation does not supply any specific¹ reason that the skilled artisan would be motivated to provide such “sealing” to a roof module as particularly described in claims 6 and 14 (i.e., a roof module having a transparent panel such as a windshield).

In view of the above, Applicants point out that it would likely be improper to present a final rejection of claims 6 and 14 on a grounds alternative to that already presented since applicants have not amended claims 6 or 14 in a manner, which would necessitate such alternative grounds. In particular, the MPEP reads:

Under present practice, second or any subsequent actions on the merits shall be final, except where the examiner introduces a new ground of rejection that is neither necessitated by applicant’s amendment of the claims nor based on information submitted in an information disclosure statement filed during the period set forth in 37 CFR 1.97(c) with the fee...” MPEP 706.07(a)

Thus, any new grounds of rejection, “that is neither necessitated by applicant’s amendment of the claims nor based on information submitted in an information disclosure statement filed during the period set forth in 37 CFR 1.97(c) with the fee...” would be improper.

• Claims 17 and 18

Applicants traverse the rejection of claims 17 and 18 on the grounds that the Examiner has repeatedly failed to show a reference that discloses an adhesive securing of a “bottom end” of a transparent panel (e.g., a windshield) to a body portion of a vehicle in conjunction with the assembling of a roof module as described in claims 17 and 18 to the body portion of the vehicle. Moreover, Applicants traverse the rejection of claims 17 and 18 on the grounds that the motivations to combine the five references (i.e., Hill et al., Miyazaki et al., Hsieh, Bhat et al., and Lumpe et al.) used to reject claims 17 and 18 are inadequate to maintain an obviousness rejection.

¹ See below for the law set down in the case of In re Lee, 61 USPQ2d 1430, 1433 requiring a “specific” motivation for combining references.

Moreover, the rejection of claims 17 and 18 are merely a hindsight reconstruction of claims 17 and 18.

I. Failure to Show Adhesive Securing of the “Bottom End”

In response to the Office Action of September 8, 2003, and in discussing that Office Action, Applicants wrote:

... the Office Action [of 11-8-03], at Page 5, suggests that Hill et al. discloses, “adhesively securing the windshield to the body portion of the vehicle...” and directs attention to the following sections of Hill et al.: column 2, lines 18-27 and 43-67 and column 3, lines 1-7 and figure 2. After review of those sections and Hill et al., Applicants find no mention of adhesively securing a windshield to a body portion of the vehicle. While, Hill et al. may arguably disclose adhesive securing of the pillars 52 and 54, there appears to be no suggestion of adhesively securing the windshield. As such, Applicants suggest that the Office Action fails to assert a prima facie case of obviousness against the present application and the rejection of claims 9-16 should be withdrawn.

In response to this argument, the Office Action of February 12, 2004 reads, at page 9, that, “...one cannot show nonobviousness by attacking references individually...” citing In re Keller and In re Merck & Co. However, as applicants pointed out in their response to the Office Action of February 12, 2004, which was not entered, both In re Keller and In re Merck & Co. deal with situations in which an Applicant for patent has attempted to rebut a prima facie case of obviousness by arguing against a single reference. In the present case, however, Applicants are suggesting that **such a prima facie case has never been established**. In particular, applicants are suggesting that the assertion by the Office Action that Hill et al. discloses “adhesively securing a windshield to a body portion of the vehicle” appears to be false and Hill et al. certainly does not disclose adhesive securing of a “bottom end” of a windshield to a vehicle body. Thus, the Office Action does not show all the limitations of the claim as would be required to establish a prima facie case of obviousness. Therefore, In re Keller and In re Merck & Co. are inappropriately applied against the present application.

Hill et al. does not appear to show adhesive securing of a “bottom edge” of a “transparent panel” or “windshield” to a “body portion” of a vehicle as is reasserted by

the most recent Office Action. As such, the most recent Office Action has again failed to make a prima facie case of obviousness against at least those claims. Applicants request that the rejection of claims 17 and 18, as posited by the most recent Office Action, be withdrawn.

II. Lack of Specific Motivation

In addition to the above, Applicants traverse the rejection of claims 17 and 18 on the grounds that the motivations to combine the five references (i.e., Hill et al., Miyazaki et al., Hsieh, Bhat et al., and Lumpe et al.) used to reject claims 17 and 18 are insufficient to maintain an obviousness rejection. In particular, the motivation to combine Bhat et al. with the teachings of Hill et al., Miyazaki et al. and Hsieh is inadequate to maintain an obviousness rejection. Moreover, the motivation to combined Lumpe et al. with Hill et al., Miyazaki et al., Hsieh and Bhat et al is also inadequate to maintain an obviousness rejection.

The Court of Appeals for the Federal Circuit, in the case of In re Lee, 61 USPQ2d 1430 (CAFC 2002), wrote:

("Our case law makes clear that the best defense against the subtle but powerful attraction of a hindsight-based obviousness analysis is rigorous application of the requirement for a showing of the teaching or motivation to combine prior art references.");...

The need for specificity pervades this authority. See, e.g., In re Kotzab, 217 F.3d 1365, 1371, 55 USPQ2d 1313, 1317 (Fed. Cir. 2000) ("particular findings must be made as to the reason the skilled artisan, with no knowledge of the claimed invention, would have selected these components for combination in the manner claimed"); In re Rouffet, 149 F.3d 1350, 1359, 47 USPQ2d 1453, 1459 (Fed. Cir. 1998) ("even when the level of skill in the art is high, the Board must identify specifically the principle, known to one of ordinary skill, that suggests the claimed combination. In other words, the Board must explain the reasons one of ordinary skill in the art would have been motivated to select the references and to combine them to render the claimed invention obvious."); In re Fritch, 972 F.2d 1260, 1265, 23 USPQ2d 1780, 1783 (Fed. Cir. 1992) (the examiner can satisfy the burden of showing obviousness of the combination "only by showing some objective teaching in the prior art or that knowledge generally available to one of ordinary skill in the art would lead that individual to combine the relevant teachings of the references").

First the motivation to combine Bhat et al. with the teachings of Hill et al., Miyazaki et al. and Hsieh is inadequate to maintain an obviousness rejection. In particular, the motivation provided by the Office Action is illogical and is not supported by the references used to reject claims 17 and 18.

The Office Action reads, at page 12, that, "it would have been obvious...to have used an adhesive having an elongation that is greater than about 300 percent in the method of Hill et al./Miyazaki et al./Hsieh, in light of the teachings of Bhat et al., in order to shorten production time." However, Applicants find no indication from any of the references of record that the use of an adhesive having an elongation of about 300 percent is likely to "shorten production time." Moreover, Applicants do not see the logic in suggesting that the elongation percentage of an adhesive has a substantial effect on production times. As such, Applicants assert that this motivation is an illogical hindsight attempt to reconstruct the invention of claims 17 and 18 and the motivation has no basis in the references of record. Applicants request that the rejection of claims 17 and 18 based upon combining Bhat et al. with other references be withdrawn.

The motivation to combine Lumpe et al. with the teachings of Hill et al., Miyazaki et al., Hsieh and Bhat et al. is also inadequate to maintain an obviousness rejection. In particular, the motivation provided by the Office Action is not supported by the references used to reject claims 17 and 18 and is merely a hindsight attempt to reconstruct the invention of claims 17 and 18 based upon conjecture.

The Office Action reads, at page 13, that, "it would have been obvious...to have connected the roof portion of Hill et al./Miyazaki et al./Hsieh/Bhat et al, to a pair of B-pillars and a pair of C-pillars, in light of the teachings of Lumpe et al., in order to provide stiffening of the body of the vehicle." However, Applicants find no indication from any of the references of record that attachment of a roof module as recited in claims 17 and 18 would provide a stiffer body of an automotive vehicle, particularly when the roof module is like the one in claims 17 and 18. Moreover, Applicants suggest that this motivation is merely provided by the Examiner's own guesswork or conjecture and has no basis of support from any objective evidence. As such, Applicants assert that this motivation is a hindsight attempt to reconstruct the invention

of claims 17 and 18 base upon the aforementioned unsupported conjecture. Applicants request that the rejection of claims 17 and 18 based upon combining Lumpe et al. with other references be withdrawn.

Moreover, Applicants point out that it would likely be improper to present a final rejection of claims 17 and 18 on a grounds alternative to that already presented since applicants have not amended claim 17 and 18 in a manner, which would necessitate such alternative grounds. In particular, the MPEP reads:

Under present practice, second or any subsequent actions on the merits shall be final, except where the examiner introduces a new ground of rejection that is neither necessitated by applicant's amendment of the claims nor based on information submitted in an information disclosure statement filed during the period set forth in 37 CFR 1.97(c) with the fee..." MPEP 706.07(a)

Thus, any new grounds of rejection, "that is neither necessitated by applicant's amendment of the claims nor based on information submitted in an information disclosure statement filed during the period set forth in 37 CFR 1.97(c) with the fee..." would be improper.

Claim 20

The Office Action rejected claim 20 stating that, "Official Notice is taken in that it is known to assemble a roof module in one area and assemble it to a body portion of an automotive vehicle in another area." Applicants suggest, however, that this conclusory statement is inadequate to establish a prima facie case of obviousness.

As stated in the MPEP 2143.03, "To establish prima facie obviousness...all the claim limitations must be taught or suggested by the prior art." Moreover, the CAFC has made clear in its caselaw that, "there must be some motivation, suggestion, or teaching of the desirability of making the specific combination that was made by the applicant" In re Lee 61 USPQ2d 1430, 1433 referencing In re Fine 5 USPQ2d 1596, 1600 (CAFC 1988), Emphasis Added. The conclusory statement that, "it is known to assemble a roof module in one area and assemble it to a body portion of an automotive vehicle in another area ..." does not establish that such an assembly

process is known, nor does the conclusory statement establish any motivation to use such a process in the method of claim 20 as presently written.

Moreover, Applicants point out that it would likely be improper to present a final rejection of claims 20 on a grounds alternative to that already presented since applicants have not amended claim 20 in a manner, which would necessitate such alternative grounds. In particular, the MPEP reads:

Under present practice, second or any subsequent actions on the merits shall be final, except where the examiner introduces a new ground of rejection that is neither necessitated by applicant's amendment of the claims nor based on information submitted in an information disclosure statement filed during the period set forth in 37 CFR 1.97(c) with the fee..." MPEP 706.07(a)

Thus, any new grounds of rejection, "that is neither necessitated by applicant's amendment of the claims nor based on information submitted in an information disclosure statement filed during the period set forth in 37 CFR 1.97(c) with the fee..." would be improper.

By amending the application, the Applicants do not concede that the patent coverage available to them would not extend as far as the original claim. Rather, Applicants intend to file a continuation application to pursue the breadth of the claims as filed. Applicants believe that the Examiner has not made a sufficient showing of inherency of the teachings of the asserted prior art, especially given the lack of teachings in the cited references of the properties that Applicants have recited in their claims.

Further, by the present amendment, it does not follow that the amended claims have become so perfect in their description that no one could devise an equivalent. After amendment, as before, limitations in the ability to describe the present invention in language in the patent claims naturally prevent the Applicants from capturing every nuance of the invention or describing with complete precision the range of its novelty or every possible equivalent. See, Festo Corp. v. Shoketsu Kinzoku Kogyo Kabushiki Co., 62 USPQ2d 1705 (2002). Accordingly, the foregoing amendments are made specifically in the interest of expediting prosecution and there

is no intention of surrendering any range of equivalents to which Applicants would otherwise be entitled.

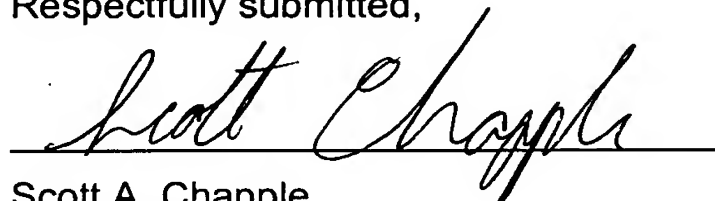
CONCLUSIONS

In view of Applicants' amendments and remarks, the Examiner's rejections are believed to be rendered moot. Accordingly, Applicants submit that the present application is in condition for allowance and requests that the Examiner pass the case to issue at the earliest convenience. Should the Examiner have any question or wish to further discuss this application, Applicant requests that the Examiner contact the undersigned at (248) 593-9900.

If for some reason Applicant has not requested a sufficient extension and/or have not paid a sufficient fee for this response and/or for the extension necessary to prevent the abandonment of this application, please consider this as a request for an extension for the required time period and/or authorization to charge our Deposit Account No. 04-1512 for any fee which may be due.

Dated: 8-18, 2004

Respectfully submitted,

A handwritten signature in cursive script, reading "Scott A. Chapple", is written over a horizontal line.

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